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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,874	03/26/2001	Noel Roger Wakelin	1029.65160	8699

24978 7590 07/01/2003

GREER, BURNS & CRAIN  
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CHICAGO, IL 60606

EXAMINER

TRAN, LOUIS B

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/744,874

Applicant(s)

WAKELIN ET AL.

Examiner

Louis B Tran

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. This action is in response to applicant's amendment, Paper No. 10, received on 04/30/2003. Applicant's cancellation of claims 12 and 13 in Paper No. 10 is acknowledged.

***Priority***

2. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. PCT /NZ99/00121 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be made in this application. In making such claim, applicant may simply identify the application containing the priority papers.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 and 11 recites the limitation "the nail gun" in line 4 of the claims. There is insufficient antecedent basis for this limitation in the claim. Previously, a hand tool is only described.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Fox (5,598,892).

With respect to claim 1, Fox anticipates a handle 60 for attaching to a trigger 62 operated hand tool wherein the handle includes a shaft 22 adapted so as to be attachable at one end thereof to the hand tool 12, a hand grip 60 located at the other end of the shaft, a trigger activator positioned near the hand grip capable of being operatively connected to the trigger associated with the hand tool, and the hand grip is angled with respect to the longitudinal axis of the shaft to allow the handle to be easily gripped by a person's hand and wherein the hand grip includes a second hand grip positioned on the shaft at a point intermediate to the two ends of the shaft, the second hand grip being adjustably positioned along the length of the shaft as seen in Figure 1 of Fox.

With respect to claim 2, Fox anticipates wherein the trigger operated hand tool is motorized as described in column 1, lines 4-7.

With respect to claim 3, Fox anticipates wherein the trigger operated hand tool is a nail gun as described in column 1, lines 4-7.

With respect to claim 5, Fox anticipates wherein the shaft includes a clamp 40 at one end thereof capable of holding a nail gun.

With respect to claim 7, Fox anticipates wherein the trigger activator is in the form of a lever 62 as seen in Figure 1.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (5,598,892).

With respect to claim 1, Fox discloses the invention substantially as claimed above and furthermore mere adjustability has been found to be obvious. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide adjustability to a handle, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954)

With respect to claim 4, Fox discloses the claimed invention except for a shaft is substantially a length of 50 cm to 70 cm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to find the optimum range for a shaft, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

9. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (5,598,892) in view of Swiderski, Jr. et al. (4,147,220).

Fox discloses the invention substantially as claimed including wherein a cable 64 is attached at its opposite to a second lever which is pivoted via the relative shortening or lengthening of the cable, to control activation of the trigger associated with a nail gun (as in claim 11), and wherein one end a connected to the lever such that pivoting of the lever causes the relative length of the cable to increase or decrease for the purpose of controlling activation of the trigger associated with a nail gun (as in claim 10) but does not specifically show a cable to control activation of the trigger associated with the nail gun.

However, Swiderski, Jr. et al. teaches the use of a cable 16 to control activation of the trigger associated with the nail gun for the purpose transmitting force in substantially the same way as does the human finger as in column 1, line 31.

Therefore, it would have been obvious to one having ordinary skill in the art to provide a cable in order to actuate a power tool at a removed distance for transmitting a force.

10. Claims 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (5,598,892) in view of Causey et al. (4,207,675).

Fox discloses the invention substantially as claimed but does not show wherein the trigger activator is in the form of a button or switch.

However, Causey et al. teaches the use of a trigger activator this is in the form of a button or switch as seen in Figure 1 and 3, and also shows wherein the trigger activator is electrically connected to the trigger mechanism of the hand tool (as in claim 8), wherein the trigger activator is electrically connected to the electric device configured

to be capable of operating the trigger associated with the hand tool (as in claim 9) for the purpose of controlling the flow of power to operate the hand tool as in column 6, lines 6-25.

Therefore, it would have been obvious to one having ordinary skill in the art to provide Fox with a switch or button instead of a lever to control power in a tool.

Furthermore, applicant has stated in the remarks portion of paper no. 10, page 7, line 1, "Anyone of ordinary skill, based on the specification as filed would know to place the button switch near the grip in similar fashion to the lever. Furthermore, the conversion of electrical to mechanical energy is common in the mechanical arts, as is exemplified by solenoids, which are widely used in many applications. The disposition of the electrical device relative to the tool is also easily within the knowledge of one of ordinary skill, as the device needs to be positioned in operational relationship to the trigger."

### ***Conclusion***

11. Applicant's remarks have been fully considered but are deemed moot in view of the new grounds of rejection.

Applicant has added new claim language stating "...the second hand grip being adjustably positioned along the length of the shaft." Given its broadest reasonable interpretation, the Fox applied prior art still reads on the claims language. The second handle of Fox is adjustably positioned (as seen in Figure 1 phantom lines) along the length of the shaft. Fox's second handle is positioned along the length of the shaft in all

the different phantom positions shown. All adjustable positions of Fox are along the length of the shaft.

For the reasons above, the grounds of rejection are deemed proper.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis B Tran whose telephone number is 703-305-0611. The examiner can normally be reached on 8AM-6PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.




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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

lbt  
June 30, 2003



Stephen F. Gerrity  
Primary Examiner